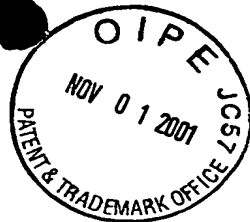


Docket No. 7791-0081-25X



#15
RWB
11-6-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

:

David ROCHON

: EXAMINER: STAMBER

SERIAL NUMBER: 09/418,509

: GROUP ART UNIT 2162

FILED: OCTOBER 15, 1999

FOR: A SYSTEM AND METHOD FOR
DELIVERING TARGETED
SAMPLES AND MEASURING
CONSUMER ACCEPTANCE
VIA A COMPUTER NETWORK

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37 CFR 1.192 APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Final Office Action dated August 13, 2001, applicant appeals.

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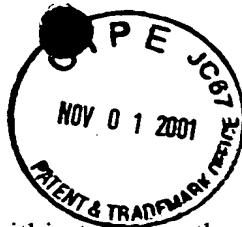


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I. **37 CFR 1.192(a)**

This brief is filed within two months from the date of the Notice of Appeal. The Notice of Appeal is filed herewith. This brief is accompanied by the fee set forth under 37 CFR 1.17(c)(\$320.00) and the fee for the Notice of Appeal (\$320.00). Arguments and authorities that the appellant relies upon to maintain the appeal are enclosed below.

II. **37 CFR 1.192(b)**

This section is inapplicable.

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III. **37 CFR 1.192(c)**

The applicant is represented by a registered practitioner. Accordingly, the following subsections comply with the subsections of 37 CFR 1.192(c).

A. **37 CFR 1.192(c)(1) Real Party in Interest**

The real party in interest is Catalina Marketing Corporation, a Florida Corporation.

B. **37 CFR 1.192(c)(2) Related Appeals and Interferences**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision on the pending appeal.

C. **37 CFR 1.192(c)(3) Status of Claims**

Claims 1-37 are pending. Claims 1-37 are the claims appealed.

D. **37 CFR 1.192(c)(4) Status of Amendments**

No amendments have been filed since the final rejection dated 8/13/01.

E. **37 CFR 1.192(c)(5) Summary of Invention**

The invention comprises a computer network method, system, and program that

perform the following procedures. The computer network gathers profile data from a computer user, transmits a manufacturer's sample offer (if the user's profile data meets the user profile criteria of the manufacturer), and generates instructions for providing product sample to the user (if the user accepts the offer). Additionally, the invention stores such profile data in a consumer database, requests consumer feedback on the product, gathers postal mailing information (so that coupons or products can be mailed).

The invention comprises a system and method that depend transmitting a manufacturer's sample offer for a product sample to a user upon the user's profile data meeting user profile criteria associated with the manufacturer's product sample offer.

F. 37 CFR 1.192(c)(6) Issues

Issue No. 1: Whether the rejections under 35 USC 101 of claims 31, 34, and 37 based upon alleged lack of utility should be reversed.

Issue No. 2: Whether the rejections under 35 USC 112 of claims 31, 34, and 37 based upon lack of enablement should be reversed.

Issue No. 3: Whether the rejections under 35 USC 102(b) of claims 1-37 based upon the WO 97/23838 publication should be reversed.

G. 37 CFR 1.192(c)(7) Grouping of Claims

Group 1 defines a computer network method or system that conditions transmitting a manufacturer's sample offer for a product sample to the user upon the user's profile data meeting user profile criteria associated with the manufacturer's product sample offer.

Group 1 contains claims 1 and 16.

Group 2 further defines a method or system for determining whether the user profile data meet the user profile criteria associated with the manufacturer's product sample offer for

a sample of the product.

Group 2 contains claims 2 and 17.

Group 3 further defines a method or system for determining whether user accepts the manufacturer's product sample offer.

Group 3 contains claims 3 and 18.

Group 4 further defines a method or system for determining whether the user buys the product for which instructions for a product sample offer has been generated.

Group 4 contains claims 4 and 19.

Group 5 further defines a method or system for storing profile data in a consumer database.

Group 5 contains claims 5 and 20.

Group 6 further defines a method or system for soliciting feedback regarding the product.

Group 6 contains claims 6 and 21.

Group 7 further defines a method or system for acquiring user's postal mailing address.

Group 7 contains claims 7 and 22.

Group 8 further defines a method or system for transmitting the user's postal mailing address to a network address for a third party.

Group 8 contains claims 8 and 23.

Group 9 further defines a method or system for mailing user a coupon discounting the full price of the sample.

Group 9 contains claims 9 and 24.

Group 10 further defines a method or system for mailing the sample product to the

user.

Group 10 contains claims 10 and 25.

Group 11 further defines a method or system for transmitting an electronic discount or coupon (for the full price of the sample) if the user accepts the manufacturer's product sample offer.

Group 11 contains claims 11 and 26.

Group 12 further defines a method or system for sending email to the user.

Group 12 contains claims 12 and 27

Group 13 further defines a method or system for storing a user's profile and purchase data with a unique identifier. This can comprise the following further steps: first, determining consumer conversion based on purchase data stored in the database; and second, transmitting the manufacturer's sample offer if the user's profile and purchase history match the profile and purchase history criteria associated with receiving the manufacturer's sample offer.

Group 13 contains claims 13-15 and 28-30.

Group 14 further defines a computer program product wherein the program performs the functions of transmitting a manufacturer's product sample offer if user profile data meets user profile criteria determined by the manufacturer.

Group 14 contains claims 31.

Group 15 further defines a method for transmitting a manufacturer's sample offer for a sample of a packaged good product.

Group 15 contains claims 32 and 33.

Group 16 further defines the same limitation as group 15 and contains claim 34.

Group 17 further defines a system wherein the main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged good product and to

generate instructions for packing and shipping that sample to the user.

Group 17 contains claims 35 and 36.

Group 18 further defines the same limitation as group 17 and includes claim 37.

H. 37 CFR 1.192(c)(8) Argument

See the following subsections.

1. 37 CFR 1.192(c)(8)(i) and (v) Rejections under The First Paragraph of 35 USC 112 and 35 USC 101

The examiner rejects claims 31, 34, and 37 under 35 USC 112 and states as follows:

“Specifically, since the claimed invention is not supported by either an asserted utility or a well established utility . . . one skilled in the art clearly would not know how to use the claimed invention.”¹ The examiner relies upon the same reasoning for the 35 USC 101 rejections. In reply, applicant asserts (1) that the invention is supported by an asserted utility (see pages 2 and 3) and (2) that this is an improper basis for a rejection in an electrical arts case.

a. Groups 14, 16, and 18

Rejected claims 31, 34, and 37 are in Groups 14, 16, and 18. The 112 and 101 rejections of these claims is improper for the reasons just stated. Therefore, the rejection of this group of claims should be reversed.

2. 37 CFR 1.192(c)(8)(ii) Rejections under The Second Paragraph of 35 USC 112

This subsection is not applicable. There are no second paragraph rejections.

¹See Final Office Action dated 8/13/01, page 3.

3. **37 CFR 1.192(c)(8)(iii) Rejections under 35 USC 102**

The examiner stated that claims 1-37 were rejected under 35 USC 102(b) based upon WO 97/23838.² In reply, applicant asserts that the WO 97/23838 publication does not anticipate the claims in the Rochon application.

a. **Group 1**

The WO 97/23838 publication does not disclose or suggest depending the transmission of a manufacturer's product sample offer to the user upon whether the user's profile data meet user profile criteria associated with the manufacturer's product sample offer. In contrast, independent claims 1, 16, and 31 define that limitation. Therefore, the rejections of all claims should be reversed.

b. **Group 2**

The WO 97/23838 publication does not disclose or suggest a method or system for determining if the user's profile data meet the user profile criteria associated with the manufacturer's sample offer for a sample of the product. In contrast, claims 2 and 17 define that limitation. Therefore, the rejection of this group of claims should be reversed.

c. **Group 3**

The WO 97/23838 publication does not disclose or suggest a method or system for determining whether the main computer receives a signal indicating that the user accepts the manufacturer's sample offer. In contrast, claims 3 and 18 define that limitation. Therefore, the rejection of this group of claims should be reversed.

²See Final Office Action dated 8/13/01, page 2.

d. **Group 4**

The WO 97/23838 publication does not disclose or suggest a method or system for determining whether the user buys the product for which instructions for receiving a sample offer have been generated. In contrast, claims 4 and 19 define that limitation. Therefore, the rejection of this group of claims should be reversed.

e. **Group 5**

The WO 97/23838 publication does not disclose or suggest a method or system for storing profile data in a consumer database. In contrast, claims 5 and 20 define that limitation. Therefore, the rejection of this group of claims should be reversed.

f. **Group 6**

The WO 97/23838 publication does not disclose or suggest a method or system for soliciting feedback regarding the product. In contrast, claims 6 and 21 define that limitation. Therefore, the rejection of this group of claims should be reversed.

g. **Group 7**

The WO 97/23838 publication does not disclose or suggest a method or system for prompting the user to provide the user's postal mailing address. In contrast, claims 7 and 22 define that limitation. Therefore, the rejection of this group of claims should be reversed.

h. **Group 8**

The WO 97/23838 publication does not disclose or suggest a method or system for transmitting the user's postal mailing address from the main computer to the network address for a third party. In contrast, claims 8 and 23 define that limitation. Therefore, the rejection of this group of claims should be reversed.

i. **Group 9**

The WO 97/23838 publication does not disclose or suggest a method or system for mailing the user a coupon discounting the full price of the sample to the postal mailing address of the user. In contrast, claims 9 and 24 define that limitation. Therefore, the rejection of this group of claims should be reversed.

j. **Group 10**

The WO 97/23838 publication does not disclose or suggest a method or system for mailing the sample to the user. In contrast, claims 10 and 25 define that limitation. Therefore, the rejection of this group of claims should be reversed.

k. **Group 11**

The WO 97/23838 publication does not disclose or suggest a method or system for transmitting an electronic discount or coupon to a point of sale terminal for the full price of the sample if the main computer indicates that the user accepts the manufacturer's offer. In contrast, claims 11 and 26 define that limitation. Therefore the rejection of this group of claims should be reversed.

l. **Group 12**

The WO 97/23838 publication does not disclose or suggest a method or system for sending email over the computer network to the user. In contrast, claims 12 and 27 define that limitation. Therefore, the rejection of this group of claims should be reversed.

m. **Group 13**

The WO 97/23838 publication does not disclose or suggest a method or system for storing a user's profile and purchase data with a unique identifier in a consumer database. In

contrast, claims 13 and 28 define that limitation.

Nor does the publication disclose or suggest using the method or system of claims 13 and 28 to determine consumer conversion based at least in part on purchase information stored in the consumer database. In contrast, claims 14 and 29 further define that limitation.

Finally, the publication does not disclose or suggest using the method or system of claims 13 and 28 to depend the transmission of the manufacturer's sample offer based on user profile criteria *and* purchase history stored in the consumer database. In contrast, claims 15 and 30 further define that limitation.

Therefore, the rejection of this group of claims should be reversed.

n. Group 14

The WO 97/23838 publication does not disclose or suggest a product wherein the program transmits the manufacturer's sample offer (if user profile data meets user profile criteria associated with the manufacturer's sample offer for a sample of the product). In contrast, claim 31 defines this limitation. Therefore, the rejection of this group of one claim should be reversed.

o. Groups 15 and 16

The WO 97/23838 publication does not disclose or suggest a method for transmitting a manufacturer's sample offer for a sample of a packaged good product. In contrast, claims 32 and 33 define these limitations. Therefore, the rejection of this group of claims should be reversed.

p. Groups 17 and 18

The WO 97/23838 publication does not disclose or suggest a system wherein the main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged

good product and to generate instructions for packing and shipping that sample to the user. In contrast, claims 35-37 define these limitations. Therefore, the rejection of these groups of claims should be reversed.

4. 37 CFR 1.192(c)(8)(iv) Rejections under 35 USC 103

This subsection is not applicable.

IV. 37 CFR 1.192(c)(9) Appendix - Copy of Claims on Appeal

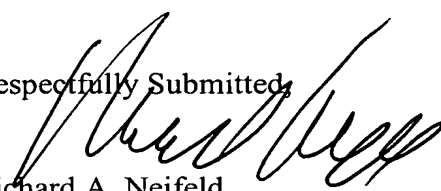
The appendix contains copies of claims 1-37 under appeal.

V. 37 CFR 1.192(d) Noncompliant Brief

This subsection is not applicable.

12/31/01
Date

Respectfully Submitted,


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APPENDIX

1. (Not Amended) A computer network implemented method, comprising the steps of:

transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

transmitting a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

2. (Not Amended) The method of claim 1, further comprising the step of:

determining if said user's profile data meets said user profile criteria associated with said manufacturer's sample offer for a sample of said product.

3. (Not Amended) The method of claim 1, further comprising the step of:

determining if said main computer receives said signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

4. (Previously Once Amended) The method of claim 1, further comprising the step of:

determining if said user purchases a product for which said instructions for providing said sample of said product are generated.

5. (Not Amended) The method of claim 1, wherein said transmitting said

manufacturer's sample offer comprises the step of:

storing said profile data in a consumer database.

6. (Not Amended) The method of claim 1, further comprising the step of:

transmitting a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer.

7. (Not Amended) The method of claim 1, wherein said step of transmitting a signal comprises:

transmitting a signal prompting said user to provide said user's postal mailing address.

8. (Not Amended) The method of claim 1, further comprising the step of:

transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party.

9. (Not Amended) The method of claim 1, further comprising the step of:

mailing a coupon discounting a full price of said sample to a postal mailing address of said user.

10. (Not Amended) The method of claim 1, further comprising the step of:

mailing said sample to a postal address for said user.

11. (Not Amended) The method of claim 1, wherein said step of delivering

comprises:

transmitting an electronic discount or coupon to a point of sale terminal for the full price of said sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's sample.

12. (Not Amended) The method of claim 1, wherein said step of transmitting said manufacturer's sample offer comprises the step of:

sending email over the computer network to said user.

13. (Not Amended) The method of claim 1, further comprising the step of:
storing said profile data and purchase data regarding a user's purchase in association
with a unique identifier uniquely identifying said user in a consumer database.

14. (Not Amended) The method of claim 13, further comprising the step of:
determining consumer conversion based at least in part on said purchase data stored in
said consumer database.

15. (Not Amended) The method of claim 13, further comprising the step of:
transmitting said manufacturer's sample offer from said main computer over said
computer network to said network address for said user's computer only if said user's profile
data meets said user profile criteria and said purchase history data meets purchase history
criteria associated with said manufacturer's sample offer for said sample of said product.

16. (Previously Once Amended) A computer network system, comprising:
a main computer, said main computer configured:
to transmit a signal prompting a user to provide profile data including identification of
the user from over a computer network to a network address for the user's computer;
to transmit a manufacturer's sample offer from said main computer over said
computer network to said network address for said user's computer if said user's profile data
meets user profile criteria associated with a manufacturer's sample offer for a sample of a
product; and

to generate instructions for providing said sample of said product to said user in
response to receipt of a signal transmitted over said computer network indicating said user
accepts said manufacturer's sample offer.

17. (Not Amended) The system of claim 16, further comprising;
means for determining if said user's profile data meets said user profile criteria

associated with said manufacturer's sample offer for a sample of said product.

18. (Not Amended) The system of claim 16, further comprising;

means for determining if said main computer receives said signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

19. (Previously Once Amended) The system of claim 16, further comprising:

means for determining if said user purchases a product for which said main computer is configured to generate instructions for providing said sample of said product.

20. (Not Amended) The system of claim 16, further comprising:

a consumer database storing said profile data.

21. (Not Amended) The system of claim 16, further comprising:

means for transmitting a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer.

22. (Previously Once Amended) The system of claim 16, further comprising;

means for transmitting a signal prompting said user to provide said user's postal mailing address.

23. (Not Amended) The system of claim 16, further comprising:

means for transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party.

24. (Not Amended) The system of claim 16, further comprising:

means for mailing a coupon for a free one of said samples to a postal mailing address of said user.

25. (Not Amended) The system of claim 16, further comprising:

means for mailing said sample to a postal address for said user.

26. (Not Amended) The system of claim 16, further comprising:

means for transmitting an electronic discount or coupon to a point of sale terminal for the full price of a sample in a current transaction, if said main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's sample.

27. (Not Amended) The system of claim 16, further comprising:

means for sending email over the computer network to said user.

28. (Not Amended) The system of claim 16, further comprising:

means for storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database.

29. (Previously Once Amended) The system of claim 28, further comprising:

means for determining consumer conversion based at least in part on said purchase data stored in said consumer database.

30. (Previously Once Amended) The system of claim 28, further comprising:

means for transmitting said manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer only if said user's profile data meets said user profile criteria and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product.

31. (Not Amended) A computer program product storing computer instructions for performing a network implemented method, said program comprising means for performing the steps of:

transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

transmitting a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

32. (Not Amended) The method of claim 1, wherein said step of transmitting a manufacturer's sample offer for a sample of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product.

33. (Not Amended) The system of claim 16, wherein said main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged good product.

34. (Not Amended) The product of claim 31, wherein said means for performing said step of transmitting a manufacturer's sample offer for a sample of a product comprises means for transmitting a manufacturer's sample offer for a sample of a packaged good product.

35. (Not Amended) The method of claim 1, wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user.

36. (Not Amended) The system of claim 16, wherein said main computer is configured to generate instructions for packing and shipping the sample of the product to said user.

37. (Not Amended) The product of claim 31, wherein said means for performing said step of generating instructions for providing said sample of said product to said user

comprises means for generating instructions for packing and shipping the sample of the product to said user.